Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte HERVE BAZIN and DOMINIQUE LATINNE

Appeal No. 2001-1746
Application No. 09/056,072

ON BRIEF

Before WINTERS, SCHEINER, and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

ORDER TO SHOW CAUSE

Appellants request rehearing of the Board's decision entered July 31, 2003 (Decision), affirming the examiner's rejection of:

claims 30-32 and 35-37 under 35 U.S.C. § 102(b) as anticipated by Xia, and

claims 30-37 under 35 U.S.C. § 103 as being unpatentable over Xia in view of either Queen or Newman, further in view of any one of Gückel, Bromberg, Hafler, Chavin, or Faustman.

Appellants, however, fail to state with particularity the points believed to have been misapprehended or overlooked with regard to our decision affirming the examiner's rejection of:

> claims 30-44 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 18-19 of Bazin I, and
>
> claims 30-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of Bazin II.

Of particular interest is that the examiner included all of appellants' pending claims in the rejection under the judicially created doctrine of obvousness-type double patenting over Bazin I. Accordingly, affirming this rejection disposed of all claims on appeal. Stated differently, even assuming arguendo that we considered appellants' request and agreed with their arguments, the holding in this case would not change.

Accordingly, appellants are ordered to show cause why:

1. This Merits Panel should not deny a request for rehearing that fails to address an affirmed rejection that disposes of all appealed claims.[1]

2. A terminal disclaimer was not timely filed in this record.[2]

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[1] Cf. In re Kroekel, 803 F.2d 705, 709, 231 USPQ 640, 642-43 (Fed. Cir. 1986) (argument presented before the board after decision, but not in original Briefing, is not properly before the board).

[2] See In re Deters, 515 F.2d 1152, 1157, 185 USPQ 644, 648 (CCPA 1975) ("Since no terminal disclaimer was timely filed, we sustain ... [the obviousness-type double patenting] rejection."); Cf. In re Jursich, 410 F.2d 803, 807, 161 USPQ 675 (CCPA 1969), footnotes and citations omitted, ("The record shows that appellants' assignee filed a terminal disclaimer in the Patent Office after the board decision which the board refused to consider because it was not timely presented or considered by the examiner. Appellants assign error in that action by the board, arguing that the terminal disclaimer 'eliminated the double patenting issue in the present case.' However accurate that statement may be, we cannot consider the disclaimer here....").

TIME PERIOD FOR RESPONSE

The Request for Rehearing will be summarily denied unless appellants within twenty (20) days from the date of this decision show cause why such action should not be taken. This time period is may not be extended. 37 CFR § 1.196(d).

ORDER

Sherman D. Winters)
Administrative Patent Judge)
)
Toni R. Scheiner) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
Donald E. Adams)
Administrative Patent Judge)

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